

Remarks

This amendment is in response to the Office Action dated February 3, 2006. Claim 1, 4-6, 9-10, 14, 30, 33, 35, and 38 have been amended. Claims 16-29 were previously canceled without prejudice. The Examiner indicated that claims 30-42 were withdrawn from consideration. Claims 39-42 have also been canceled without prejudice in this amendment. Claims 1-15 and 30-38 are currently pending. Reexamination and reconsideration are respectfully requested.

The specification was amended on page 6, lines 21-26, to change the reference number for the terms “silicon substrate” to “201”. Support for the change may be found in the specification and figures, for example, the sentence in the specification beginning on page 7, line 28 and extending to page 8, line 1, which refers to “silicon substrate 201” in Figs. 10-12.

Claim 1 was amended to recite in part “providing a silicon slider body comprising single crystal silicon”. Support for this amendment may be found in the specification, for example, at page 5, line 2. In addition, claims 1, 4-6, 9-10, and 14 were amended for clarity (and not to further limit the claims) to insert the term “slider” between “silicon” and “body”.

Applicant thanks the Examiner for indicating the claims 9-14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has rewritten claim 9 in independent form and respectfully submits that claims 9-14 are in patentable form.

Claims 1-3, 5-8 and 15 were rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,708,540 to Ananth et al. (“Ananth”). Claim 4 was rejected under 35 U.S.C. 103(a) as unpatentable over Ananth in view of U.S. Patent No. 5,761,790 to Carr et al. (“Carr”). The rejections are respectfully traversed.

Applicant respectfully submits that the Examiner’s citations to the art do not describe or suggest a method including all of the elements set forth in claim 1, including, “providing a silicon slider body comprising single crystal silicon; forming at least one trench in a surface of the silicon slider body; and forming a structure selected from the group consisting of a carbide structure and a nitride structure in the at least one trench.” The Examiner appears to cite Ananth for forming a slider from silicon carbide because the formation of structure B from silicon

carbide in Fig. 4' of Ananth would lead one to also form the slider from a hard material such as silicon carbide for its mechanical equivalency. Applicant does not agree that the text of Ananth suggests forming a slider from silicon carbide. Even if, for some reason, a slider were formed from the silicon carbide of the boss structure B in Ananth, applicant believes that the silicon carbide as described in Ananth would not be considered a mechanical equivalent of single crystal silicon by one of ordinary skill in the art, due to substantially different mechanical properties.

Applicant respectfully submits that the Examiner did not meet his burden to establish a prima facie case of obviousness. According the MPEP section 706.02(j), to establish a prima facie case of obviousness, the following criteria should be met. First, there should be a suggestion or motivation in the art to modify the reference or to combine reference teachings. Second, there should be a reasonable expectation of success. Third, the reference(s) must teach all the claim limitations. MPEP section 706.02(j).

Applicant respectfully submits that the Examiner's citations are insufficient to satisfy the criteria above and accordingly, the rejection of claim 1 and its dependent claims 2-3, 5-8 and 15 should be withdrawn. With respect to claim 4, applicant respectfully submits that the Examiner's citation to Carr does not overcome the deficiencies of Ananth as described above. Accordingly, the rejection of claim 4 should be withdrawn.

Claims 30-42 were indicted by the Examiner as being withdrawn. Applicant has amended claim 30 to depend from claim 1. Applicant has also made minor amendments to claims 33, 35, and 38 for clarity (not to further limit the claims). Applicant respectfully submits that claim 30 and claims 31-37 (which further depend from claim 30), should be rejoined into the application as claim 1 is in patentable form. Claim 38 depends from claim 9, and should be rejoined into the application as claim 9 is in patentable form.

Claims 39-42 have been canceled without prejudice to further prosecute the subject matter of these claims.

The Office Action included various comments concerning the art and the non-patentability of certain claims. Applicants respectfully disagree with the Examiner's non-patentability conclusions. Applicant also does not concede that the Examiner's characterization of the prior art is accurate. The discussion above has directly addressed some of the Examiner's

comments and any of the Examiner's comments not specifically discussed above are deemed moot at this time in view of this response.

Applicant respectfully submits that the pending claims are in condition for allowance. Reexamination and reconsideration are respectfully requested. If, for any reason, the application is not in condition for allowance, the Examiner is requested to telephone the undersigned to discuss the steps necessary to place the application into condition for allowance.

Respectfully submitted,

Alan S. Raynes

Alan S. Raynes
Reg. No. 39,809
KONRAD RAYNES & VICTOR, LLP
315 South Beverly Drive, Suite 210
Beverly Hills, CA 90212
Customer No. 24033

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general tele (310) 556-7983
direct tele (310) 871-8448
facsimile (310) 556-7984

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on June 5, 2006.

Alan S. Raynes _____ June 5, 2006
Alan S. Raynes Date